

JP



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,446	08/08/2001	Junichi Matsunoshita	110332	9081

25944 7590 09/12/2005

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

POON, KING Y

ART UNIT	PAPER NUMBER
----------	--------------

2624

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,446	Applicant(s) MATSUNOSHITA ET AL.	
	Examiner King Y. Poon	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Funada et al (US 5,742,408).

Regarding claim 6, Funada et al. teach an image data outputting apparatus (fig. 2) which outputs a piece of copy forgery preventing image data for preventing copy-based forgery to an image forming apparatus for forming an image based on a piece of forgery prevention target image data (column 11, line 62 - column 12, line 22, the indication data that is used to check against the particular image indicates target image data) to be protected from copy-based forgery, the image data outputting apparatus comprising: storing means for storing a plurality of pieces of forgery preventing target image data (column 11, line 62 - column 12, line 22, the indication data that is used to check against the particular image indicates target image data, which is inherently stored in order to access it) and a plurality of pieces of copy forgery preventing image data (column 12, lines 7-22 & fig 1 7B, information regarding the model number and date of use of a copy machine is used in the pattern, requiring storage of the date and model number. These numbers differ for each copy machine used. Furthermore,

Art Unit: 2624

column 8, lines 46-48, other patterns are available); retrieving and selecting means for retrieving a piece of forgery prevention target image data corresponding to information transmitted from a terminal (figs 17 & column 11 line 58 - column 12, line 22, a particular image 803, i.e. information transmitted from terminal, is read and the determination circuit 409, i.e. the retrieving means, receives the particular image and retrieves indication data, which inherently must be stored for it to be accessed, in order to check against the particular image) from the plurality of pieces of forgery prevention target image data stored in the storing means and selecting a piece of copy forgery preventing image data corresponding to the retrieved piece of forgery prevention target image data and an image forming apparatus specified for forming an image by printing (column 12, lines 7-22, the pattern generation circuit 2411 generates indication signals that corresponds to the particular image, i.e. plurality of pieces of forgery preventing target image data, and the signal selects the copy forgery preventing image data that corresponds the printing machine model number are printed, column 13, lines 5-6), and outputting means for outputting the retrieved piece of forgery prevention target image data and the selected piece of copy forgery preventing image data (figs 17 & column 12, lines 7-22, indication of particular image is output along with pattern).

Regarding claim 7, Funada et al. teach an image data outputting apparatus (fig. 2) which outputs a piece of copy forgery preventing image data for preventing copy-based forgery to an image forming apparatus for forming an image based on a piece of forgery prevention target image data (column 11, line 62 - column 12:line 22, the indication data that is used to check against the particular image indicates target image

Art Unit: 2624

data) to be protected from copy-based forgery, the image data outputting apparatus comprising: storing means for storing a plurality of pieces of forgery preventing target image data (column 11:line 62 - column 12, line 22, the indication data that is used to check against the particular image indicates target image data, which is inherently stored in order to access it); retrieving means for retrieving a piece of forgery prevention target image data corresponding to information transmitted from a terminal from the plurality of pieces of forgery prevention target image data stored in the storing means (figs 17 & column 11, line 58 - column 12, line 22, a particular image 803, i.e. information transmitted from terminal, is read and the determination circuit 409, i.e. the retrieving means, receives the particular image and retrieves indication data, which inherently must be stored for it to be accessed, in order to check against the particular image); generating means for generating a piece of copy forgery preventing image data corresponding to the retrieved piece of forgery prevention target image data and an image forming apparatus specified for forming an image by printing (column 12, lines 7-22, the pattern generation circuit 2411 generates indication signals that corresponds to the particular image, i.e. plurality of pieces of forgery preventing target image data, and the signal selects the copy forgery preventing image data that corresponds the printing machine model number, column 13,lines 5-6); and outputting means for outputting the retrieved piece of forgery prevention target image data and the selected piece of copy forgery preventing image data (figs 17 & column 12, lines 7-22, indication of particular image is output along with pattern).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funada et al (US 5,742,408) in view of Rhoads (US 6,122,403).

Regarding claim 1, Funada teaches an image data outputting apparatus (fig 2) for outputting copy forgery preventing image data for preventing copy-based forgery (column 12, line 10, pattern to be output), comprising: storing means (column 7, lines 44-46, LUT 903) for storing a plurality of pieces of copy forgery preventing image data corresponding to characteristics of a plurality of image forming apparatuses (column 12, lines 7-22 & fig 17B, information regarding the model number and date of use of a copy machine is used in the pattern, requiring storage of the date and model number. These numbers differ for each copy machine used. Furthermore, column 8, lines 46-48, other patterns are available); selecting mean for selecting a piece of copy forgery preventing image data corresponding to a characteristic of an image forming apparatus specified for forming an image from the plurality of pieces of copy forgery preventing image data stored in the storing means (column 12, lines 7-22 & fig 17B, information regarding the model number and date of use of a copy machine is used in the pattern which inherently requires a selecting means Furthermore, column 8, lines 46-48, other patterns are

Art Unit: 2624

available); and outputting means (column 12, line 9, pattern generation circuit 2411) for outputting the piece of copy forgery preventing image data selected by the selecting means to the image forming apparatus specified for forming an image (column 12, lines 7-22, a signal is sent from circuit 2411 to indicate the specifics of the pattern).

Funada et al. teach wherein the piece of copy forgery preventing image data includes at least a first pattern (fig. 10).

Funada et al. do not teach printing the piece of copy forgery preventing image data wherein the piece of copy forgery preventing image data includes at least a background portion constituted by a first pattern and a latent image portion constituted by a second pattern.

However, Rhoads in the same area of printing images for preventing forgery, teaches printing forgery preventive images includes at least a background portion (master snowy pattern, column 61, line 3) constituted by a first pattern and a latent image portion (bar code, fig. 22) constituted by a second pattern (fig. 22, column 55, lines 40-45, column 59, lines 40-45), the first pattern and the second pattern are almost equal in density (commercial imagery requires invisibility).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Funada to include: printing the piece of copy forgery preventing image data wherein the piece of copy forgery preventing image data includes at least a background portion constituted by a first pattern and a latent image portion constituted by a second pattern such that the first pattern and the second pattern are almost equal in density.

Additionally, Funada et al. teach a selecting means that selects the piece of copy forgery preventing image data so that distinguished patterns can be formed (column 8:lines 46-48), and that the pattern is printed so that the document being printed can be legibly read (column 12, lines 14-22). It follows that the background portion and the latent image portion can be almost equal in density because in distinguishing the pattern, a density is used not to interfere with the content of the print job, but only exists to indicate that the print job is replicated and not an original (after combining with Rhoads)

Regarding claim 3: Funada et al. teach an image data outputting apparatus (fig 2) for outputting copy forgery preventing image data for preventing copy-based forgery (column 12, line 10, pattern to be output), comprising: generating means (column 12, line 9, pattern generation circuit 2411) for generating copy forgery preventing image data corresponding to a characteristic of an image forming apparatus for forming an image (column 12, lines 9-14, pattern signal generation by circuit 2411 indicates a certain pattern to be output wherein said pattern includes a characteristic, i.e. a model number, of the image forming apparatus, i.e. the machine used to print) and outputting means for outputting the copy forgery preventing image data generated by the generating means to the image forming apparatus for forming an image (column 12, lines 9-30, signal is output to machine for printing).

Funada et al. teach wherein the piece of copy forgery preventing image data includes at least a first pattern (fig. 10).

Funada et al. do not teach printing the piece of copy forgery preventing image data wherein the piece of copy forgery preventing image data includes at least a background portion constituted by a first pattern and a latent image portion constituted by a second pattern.

However, Rhoads in the same area of printing images for preventing forgery, teaches printing forgery preventive images includes at least a background portion (master snowy pattern, column 61, line 3) constituted by a first pattern and a latent image portion (bar code, fig. 22) constituted by a second pattern (fig. 22, column 55, lines 40-45, column 59, lines 40-45), the first pattern and the second pattern are almost equal in density (commercial imagery requires invisibility).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Funada to include: printing the piece of copy forgery preventing image data wherein the piece of copy forgery preventing image data includes at least a background portion constituted by a first pattern and a latent image portion constituted by a second pattern such that the first pattern and the second pattern are almost equal in density.

Additionally, Funada et al. teach a selecting means that selects the piece of copy forgery preventing image data so that distinguished patterns can be formed (column 8:lines 46-48), and that the pattern is printed so that the document being printed can be legibly read (column 12, lines 14-22). It follows that the background portion and the latent image portion can be almost equal in density because in distinguishing the pattern, a density is used not to interfere with the content of the print job, but only exists

Art Unit: 2624

to indicate that the print job is replicated and not an original (after combining with Rhoads).

Response to Arguments

5. Applicant's arguments filed 6/20/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument that Chock does not teach the hologram is printed and claims 1, 3-7 are amended to recite the image (first pattern and second pattern) is formed by printing, has been considered.

In reply: Funada et al. teach wherein the piece of copy forgery preventing image data includes at least a first pattern (fig. 10).

Funada et al. do not teach printing the piece of copy forgery preventing image data wherein the piece of copy forgery preventing image data includes at least a background portion constituted by a first pattern and a latent image portion constituted by a second pattern.

However, Rhoads in the same area of printing images for preventing forgery, teaches printing forgery preventive images includes at least a background portion (master snowy pattern, column 61, line 3) constituted by a first pattern and a latent image portion (bar code, fig. 22) constituted by a second pattern (fig. 22, column 55, lines 40-45, column 59, lines 40-45), the first pattern and the second pattern are almost equal in density (commercial imagery requires invisibility).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Funada to include: printing the piece of copy forgery preventing image data wherein the piece of copy forgery preventing image data includes at least a background portion constituted by a first pattern and a latent image portion constituted by a second pattern such that the first pattern and the second pattern are almost equal in density.

Additionally, Funada et al. teach a selecting means that selects the piece of copy forgery preventing image data so that distinguished patterns can be formed (column 8:lines 46-48), and that the pattern is printed so that the document being printed can be legibly read (column 12, lines 14-22). It follows that the background portion and the latent image portion can be almost equal in density because in distinguishing the pattern, a density is used not to interfere with the content of the print job, but only exists to indicate that the print job is replicated and not an original (after combining with Rhoads)

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 2624

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 8, 2005



**KING Y. POON
PRIMARY EXAMINER**